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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,788	07/30/2003	Jean Taylor	0573-1004-1	9395

466 7590 01/28/2005

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EXAMINER

PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Applicati n No.

10/629,788

Applicant(s)

TAYLOR ET AL.

Examin r

Pedro Philogene

Art Unit

3732

-- Th MAILING DATE of this communication app ars on th cover sh et with th correspond nc addr ss --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,13-16,18,19 and 21-28 is/are rejected.
- 7) ☒ Claim(s) 3,12,17 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3,5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 5, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,5,6,9,10,11,14-16,21-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Bernhardt et al (5,591,166).

With respect to claims 1,14,16, Bernhardt et al disclose a spinal osteosynthesis device comprising at least two bone anchoring elements (20) for anchoring in respective bodies of the bone structure of the spine, at least one member (62) for longitudinal connecting the bone anchoring elements and shakles (64,68) for connecting the bone anchoring elements together, each bone anchoring element comprises a head (36) a threaded shank (28) extending from the head and a tightening element (70) which can be fitted onto this shank, the threaded shank has a ball end (22) for articulation in a housing (44) of a spherical cup (46) of the head (36), the ball and the cup have respective center of rotations which are separated by a distance; as best seen in FIGs.3,4, giving the device a function of returning the bone anchoring element by transverse force, the connector shackle for this purpose having a spherical bearing surface, as best seen in FIG.2, articulated to a portion of the spherical bearing surface of the cup of the head of the bone anchoring element.

With respect to claims 2,5,6,9,10,11,15,21-25, Bernhardt et al disclose all the limitations, as set forth in column 3, lines 35-67, column 4, lines 1-67, column 5, lines 1-30, and as best seen in FIGS.1-7.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4,9,18,19,26,27,28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernhardt et al. (5,591,166) in view of Mullane (5,628,740).

With respect to the above claims, it is noted that Bernhardt et al teach all the limitations, except for male shape designed to cooperate with a complementary female shape of a tool, and a narrow portion comprising a rotation-stopping geometry; as claimed by applicant. However, in a similar art, Mullane evidences the use of a a male shape designed to cooperate with a female shape of a tool and a narrow portion comprising a rotation stopping geometry to bias the bolt into a permanent fixed position upon attachment.

Therefore, given the teaching of Mullane, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Bernhardt et al, as taught by Mullane, to provide a device capable of biasing the bolt into a permanent position upon attachment.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernhardt et al. (5,591,166) in view of Petreto (5,938,663).

With respect to claim 7, it is noted that Bernhardt et al did not teach of a shackle having a conical bearing surface, as claimed by applicant. However, in a similar art, Petreto evidences the use of a shackle with a conical bearing surface to prevent any relative movement of the screw and the locking assembly.

Therefore, given the teaching of Petreto, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of

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Bernhardt et al., as taught by Petreto to prevent any relative movement of the screw and the shackle.

Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernhardt et al. (5,591,166) in view of Wagner (5,304,179).

With respect to claims 8 and 13, it is noted that Bernhardt et al did not teach of a shank with a transverse collar, and a tool for positioning the threaded shank; as claimed by applicant. However, in a similar art, Wagner evidences the use of a shank with a transverse collar, and a tool for positioning the threaded shank and anchoring the osteosynthesis device to the bone.

Therefore, given the teaching of Wagner, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Bernhardt et al, as taught by Wagner, and use a tool to position the threaded shank and anchor the device to the bone.

### ***Allowable Subject Matter***

Claims 3,12,17,20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,800,435

9-1998

Errico et al.

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5,735,851

4-1998

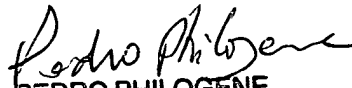
Errico et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene  
January 18, 2005

  
PEDRO PHILOGENE  
PRIMARY EXAMINER